

**Remarks:**

Claims 51-53, 56-63 and 71 are pending. Claims 51-53 and 56-63 have been rejected under 35 U.S.C. §112. Claims 51-53, 56-63, and 71 have been rejected under 35 U.S.C. §103. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 51, 52, 57, and 71 and paragraphs 27, 31 and 32 of the specification are amended. Claims 72 and 73 are added. No new matter has been added as support for the amendments is found within the specification and the drawings as originally filed and in light of the provided Declaration and Exhibits A and B. It is submitted that the Application, as amended, is in condition for allowance.

The Applicant is not conceding that the subject matter recited in the amended or canceled claims is not patentable over the art cited by the Examiner. The amended, withdrawn or cancelled claims are provided solely to facilitate expeditious prosecution of the allowable subject matter. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or cancelled claims in one or more continuing applications.

**Claim of Priority:**

Applicant notes that the Examiner has not acknowledge the Applicant's claim of foreign priority under 35 U.S.C. § 119(a). None of the boxes were marked on the Office Summary page. Please let us know if all, some or none of the copies have been received.

**Figures:**

Applicant notes that none of the boxes were marked on the Office Summary page to indicate that the Examiner has accepted the Drawings. Please advise.

**Objection to the Specification:**

The pending Office Action requests a substitute specification in proper idiomatic English in compliance with 37 CFR 1.52(a) and (b). The Applicant has thoroughly reviewed the noted sections of the Regulations and respectfully submits that the specification as filed complies with the Regulations and therefore a substitute specification is not required.

Regardless, to accommodate the Examiner a substitute specification will be filed if the currently submitted amendments to the specification do not satisfy the Examiner in correcting the identified typographical errors. It is respectfully submitted that a person of ordinary skill would have known that the typos corrected by the virtue of the present amendments were erroneous in nature. Accordingly, no new matter has been added. Support for the amendments is provided in the specification and the drawings as filed.

Further, the attention of the Examiner is directed to the attached Declaration and the accompanying exhibits in which additional support is provided for what the claimed subject matter was at the time the idea for the present application was conceived and as discussed in further detail below eventually reduced to practice with diligence by way of filing the respective Korean and US Applications.

**§112 Rejection(s):**

Claims 51-53 and 56-63 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

In particular, the Examiner has rejected the claims under §112 contending that there is no support in the original application as filed for the recited features of the claim directed to (1) non-overlapping display areas and (2) the change in aspect ratio of the image in the rotated and un-rotated states.

The Applicant respectfully submits that the above two issues are now moot. The claims as amended no longer recite the claimed subject matter with respect to an overlapping or non-overlapping feature. Further, due to the amendments to the specification (see amendments to paragraphs 27, 31 and 32), the terminology used in relation with “aspect ratio” to which the Examiner had objected, is now consistent with the Examiner’s understanding and suggestions.

The drawings (see FIG. 3B) and knowledge available to one of skill in the art, particularly when read within the context of the entire disclosure of the present Application also support the amendments made to the specification. The Applicant hereby thanks the Examiner

for pointing out certain typographical errors and respectfully draws the Examiner's attention for further support to the attached Declaration and the accompanying Exhibits A and B.

The Examiner is requested to note that the specification discloses a display screen with width A and height B and an image with height C and width D. The image has height C and width D. These dimensions are different from the dimension of the display screen as shown in FIG. 3B and recited in paragraph [0012], lines 3 and 4; paragraph [0027], lines 9 and 10 of the application. It is noteworthy that if the rotated version of the image fits in the display screen (i.e.,  $C = A$  and  $D = B$ ), the image is not resized. If, on the other hand, the rotated version of the image does not fit on the display screen, the rotated image is resized so that  $C = A$  and  $D = A^2/B$ . See paragraphs [0013] and [0029].

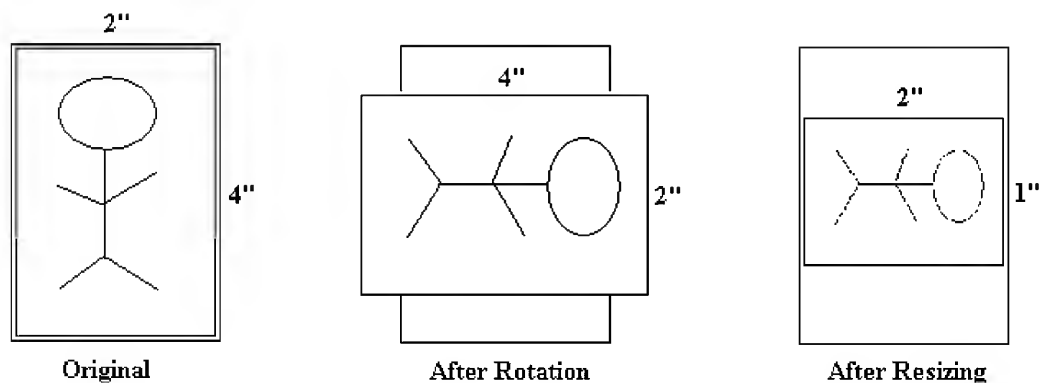
In FIGS. 3B and 3D, the image does not occupy the entire display screen due to resizing, and two soft keys are provided in the display screens empty space (i.e., a display area represented by an area formed between at least one edge of the display screen and one edge of the image) in response to rotating and resizing the image. See also paragraph [0029]. FIGS. 3A through 3D, in combination with paragraph [0029], provide that soft keys are displayed on the display screen in an area of the display screen (i.e., the second display area, as claimed) that is exclusive of the display area on which the rotated image is displayed (i.e., the second display area, as claimed).

The Examiner seems to argue that the claim language is vague with respect to what is meant by non-overlapping areas and the position of the display areas in which the icons are displayed. It is respectfully noted that the current amendments to the claims obviate said concerns if the Examiner considers the meaning of the claim language within the context of the specification and common sense.

The Examiner has also argued that having at least one of a width and a height of an image adjusted in size means that the aspect ratio is changed. Applicant respectfully disagrees. Regarding claims 52 and 57, adjusting the size of an image does not necessarily change the aspect ratio of the image. The height and width are defined based on the image, however, the

Examiner seems to confuse the height and width by defining them based on the display unit dimensions.

As shown in the following illustration, an image is originally displayed with dimensions approximately the same as a display screen such that  $A = D = 2$  inches and  $B = C = 4$  inches. The height of the image is twice the width. That is, the ratio of the height (4 inches) to the width (2 inches) of the image is 2:1. After the image is rotated 90 degrees, the image is resized to fit on the display screen such that  $A = C = 2$  inches and  $D = 1$  inch. The height of the image is still twice the width of the image. That is, the ratio of the height (2 inches) to the width (1 inch) of the image is still 2:1. Thus, the resizing adjusts the width and height of the image, but the aspect ratio remains the same.



The Examiner is reminded that support for the claims can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998).

Further, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Contrary to the Examiner’s understanding, section §112, first paragraph does not require a word-for-word matching between the language in the Specification and the language recited in the

claims. If one were to interpret §112, first paragraph, according to the Examiner's understanding, then the claim language would have to be limited to identical language used in the specification and nothing more.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the *initial burden*, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.” (Emphasis Added).

Therefore, the Examiner is requested to either withdraw the 112 grounds of rejection or provide sufficient evidence or reason why a person skilled in the art, in light of the current amendments and clarifications, would not be able to recognize that the specification and the drawings as filed would provide support for the claims, as amended. Particularly, referring to FIG. 3B, it is noted that the image shows an embodiment in which the image is rectangular (i.e., it's not a perfect square) such that when the image is rotated an empty space is formed between the image and the lower side of the display, with the icons being displayed in the empty area.

In other words, the icons in FIG. 3B are displayed in an area that is exclusive of the area in which the rotated and scaled image is displayed. The Examiner may contend, however, that there is no support in the specification for two separate display areas, because there is no word-for-word match for the terms in the specification. As discussed earlier, a word-for-word support for the claim language is not necessary in the specification in order for the specification to meet section 112 requirements.

The Examiner is referred to FIGS. 3A and 3B which illustrate that once image rotation is performed, an image height is reduced in accordance with a display width, and an image width is also reduced to prevent image distortion and to maintain the proper aspect ratio. As explicitly disclosed in paragraphs 24 through 26 of the specification, an empty space is formed due to the reduced size of the image and the icons are displayed in the empty space, such that the empty

space is defined by an area of the display that is exclusive of the other area of the display in which the image is displayed.

Further support for the above claim language can be found in the submitted documents in Exhibits A and B which include the original disclosure submitted by the inventors at the time of the conception. The images included in the disclosure show an image of a baseball player which after rotation is displayed on a first area of the display (referring to the image with a white background). As shown, the width of the rotated image is identified as “C” and the height of the image is identified as “D”. Please note that this identification of the height and width corroborates what has been illustrated in FIG. 3B, as amended.

The same image in the disclosure also shows two distinct display areas. The first display area has a white background and the second area has a gray background. In the first display area, the rotated and scaled image of the baseball player is displayed. In the second display area, the icons associated with functions for controlling image display are displayed. It is apparent from the illustrations submitted in the disclosure that the inventors were in the possession of the subject matter recited in the claims with respect to mutually exclusive display areas utilized for showing the rotated image and the respective icons.

Respectfully, Examiner’s argument that the drawings as filed, when read in light of the specification would not provide a person of ordinary skill to understand what has been taught in the disclosure is unfounded when considered in light of the strong presumption in favor of the Applicant that an adequate written description of the claimed invention is present in the specification as filed. Based on Exhibits A and B and the accompanying Declaration, the Applicant submits that if there has been any doubt on part of the Examiner as to the manner or location in which the rotated image is displayed or scaled, such doubt should be now resolved.

For the above reasons, Applicant respectfully submits that the specification fully supports the claims, when considered in light of the drawings and within the context of the explicit teachings toward a method for reducing the size of an image in conformity with aspect ratio requirements discussed in the specification. The §112 rejection should be withdrawn.

### **§103 Rejection(s):**

Claims 51-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,154,214 to Uychara et al. (hereafter “Uychara”) in view of U.S. Patent No. 5,661,632 to Register (hereafter “Register”) and U.S. Patent No. 6,748,185 to Song (hereafter “Song”). The Applicant has previously discussed Uychara and Register and how the two are distinguishable from the claimed subject matter. Examiner has now introduced in a new reference Song contending that Song teaches the rotating and scaling feature recited in the claims. The rejections are respectfully traversed.

It has been long held that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further, according to MPEP §2143,<sup>1</sup> to establish a prima facie case of obviousness, the Examiner must clearly articulate the reason(s) why the claimed subject matter would have been obvious at the time of invention. Exemplary rationales that may support a conclusion of obviousness include:

- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtain predictable results;

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<sup>1</sup> *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-1741, 82 USPQ 2d 1385, 1395-97 (2007).

- (c) Use of known technique to improve similar devices (methods, or products) in the same way;
- (d) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; etc.

Uyehara is directed to an electronic reading system which allows users to download books and other types of content to a hand-held reader device for viewing. Using software which runs on a personal computer (PC), the user can download titles from Internet sites to the PC. Titles are then automatically transferred to the device when the device is placed in a cradle which is connected to the PC. Using the device's touch-sensitive display and graphical user interface, the user can access various software-implemented features associated with the display and management of the content. One feature is a user-definable hotkey that can be "dragged and dropped" onto a menu item to create a shortcut to that item. Another feature allows the user to tap twice on a displayed word to cause the device to look the word up in a pre-specified or default reference title, such as a dictionary or an encyclopedia. Another feature allows the user to block a passage on the touch-sensitive display and then specify one or more destinations (email addresses, file folders, fax numbers, printers, etc.) for routing the passage; when the device is subsequently placed in the cradle, the passage is automatically retrieved by the PC and routed to the specified destination(s). The device also implements a user interface feature for allowing the user to rapidly and conveniently adjust the orientation of the displayed title.

Register is directed to a handheld computer has a generally rectangular housing on a front side wall of which a display screen is operatively mounted. A row of toggle switches is also mounted on the front housing side wall, adjacent the display screen, the toggle switches being operatively connected to the computer circuitry within the housing. The toggle switches are manually depressible switch members having first and second non-momentary positions. The housing may be manually grasped in two perpendicular use orientations in each of which the user may reach and operate the toggle switches to control the operation of the computer. One of the toggle switches is operative, via the internal computer circuitry, to selectively rotate, through an angle of 90 degrees, the orientation of data generated on the screen so that in either of the first and second housing use orientations the screen data is in an upright viewing orientation relative



to the user of the computer. Because the toggle switches are non-momentary, the orientation of the data generated on the screen is preserved while the handheld computer is turned off.

Song is directed to a copier that scans an original document and displays the scanned image together with a printing image of the printing paper corresponding to the scanned image. Prior to a copy operation, a printing status of the scanned image to be printed on the printing paper is checked. The user sets a position, a size and an angle of the scanned image on the printing paper. The printing paper is selected by a selecting command input from a user, or the printing paper that is closest to the scanned image in size and position can be automatically selected. The user obtains a correct copy as intended easily even when the size of the original document and the printing paper are different from each other, or when the user only wants to copy a partial image of the scanned image.

It is preliminarily noted that Song is an improper 102(e) reference because the claimed subject matter was conceived prior to the filing date of Song. That is, Song was filed on May 24, 2002, where the presently claimed subject matter was conceived on March 13, 2002. A proper declaration has been attached under 37 CFR § 1.131 to swear behind the filing date of Song. Supporting documents included in Exhibit A and B are also provided to corroborate the statements made in the 131 declaration, as duly signed by the authorized representative of the assignee of the entire interest in this Application. At least for the above reason, it is requested that the 102(e) grounds of rejection be withdrawn, due to Song being an improper reference.

Furthermore, referring to col. 6, lns. 45-55 of Song, the adjusting and scaling features of Song require user interaction with a touch screen of a copier/scanner/printer capable of showing a scanned image together with a printing image on the touch screen. Prior to printing, the user can select a rotation icon and then drag one of the apexes of the scanned image frame in a circular direction, as shown in FIG. 8D of Song.

For the above reasons, even if Song was a properly cited reference, it would still fail to cure the deficiencies of Uyehara and Register because it teaches away from the rotation methods discussed in both Uyehara and Register. That is, Uyehara and Register each suggest using a

single button press to change the orientation of the displayed image, while Song requires a two step approach which requires both a button press and a dragging feature, a feature that would not be desirable to implement in either of the other two cited references. Since Song teaches away from both Uyehara and Register, a person of ordinary skill would not have been motivated to combine the three of them in the direction of the claimed subject matter.

Uyehara, Register and Song neither alone nor in combination teach or suggest a method of controlling image display on a hand-held mobile communication terminal, the method comprising: (1) displaying an image on a display screen of a hand-held mobile communication terminal configured to communicate voice data in a wireless communication network, (2) wherein the image comprises a photographic image, (3) wherein the image is displayed over both a first display area and a second display area on the display screen, (4) wherein the first and second display areas are juxtaposed each other on the display screen, and (5) wherein a substantial portion of both the first display area and the second display area is used for displaying the image; (6) displaying a rotated version of the image on the display screen, in response to a user interacting with the mobile communication terminal, (7) wherein the image is rotated, relative to the display screen, at approximately a ninety degree angle and (8) resized so that the rotated image is displayed in its entirety in the first display area of the display screen (9) in exclusion of the second display area of the screen, (10) wherein the rotated image is a duplicate scaled version of the entire image; and (11) displaying at least first and second icons in the second display area of the display screen, (12) wherein the first and second icons are associated with functions for controlling image display on the hand-held mobile communication terminal.

The Examiner is requested to point out with specificity passages in each reference that teach or suggest the above recited elements, without engaging in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. (See *In re Wesslau*, 147 USPQ 391 (CCPA 1975)).

The question of whether a cited reference can properly be modified in a §103 rejection is not whether a particular limitation was known at time of invention, but rather whether there is a

reason that would make it obvious for one of ordinary skill in the art at the time of the invention to modify the cited reference to include that particular limitation. As the U.S. Supreme Court has affirmed, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1397 (2007).

Additionally, it is improper to use Applicant's disclosure as a road map for selecting and combining prior art references. See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). As provided in further detail below, the Applicant respectfully submits that in the absence of any legitimate reason that it would be obvious to combine the cited references, the Office Action has used Applicants' claims as a road map for modifying the cited reference.

Referring to Uyehara, the rotation icon disclosed in Uyehara is not equivalent to the first icon recited in claim 51. That is, the rotation icon disclosed in Uyehara is for displaying orientation markers, and is not associated with controlling image display, as recited in claim 51. The only icons disclosed in Uyehara that are configured to rotate the image in a first direction are the orientation markers, which are overlapped with the image having the text area, as admitted by the Examiner in the same portion of the Office Action. See also column 12, lines 5-6. Accordingly, Uyehara directly teaches away from the first icon being displayed in a second display area that is exclusive of the first display area in which the rotated image is displayed, as recited in claim 51. For this reason alone, Uyehara should be withdrawn for being an improper reference.

Uyehara also fails to teach or suggest rotating the image in a first direction, wherein the first directional key flickers to indicate a change in the image's orientation; and resizing the rotated image so that C is approximately equal to A and D is approximately equal to square of A divided by B, in response to determining that the rotated image does not fit entirely on the

display screen, as recited in claim 71. Applicant has reviewed Uyehara, but cannot find any portion of Uyehara that teaches or suggests the above elements.

Particularly, in Uyehara the displayed text characters are re-arranged due to the rotation function and the text-wrapping feature. In other words, the text disclosed in Uyehara is not an image within the context claimed and is not rotated and resized in the manner an image is rotated and resized. Therefore, the rotation of the text as suggested in Uyehara will result in a different image being displayed on the screen after the rotation.

In addition, since Uyehara teaches away from claim 51, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Uyehara with any other reference. Even assuming, *arguendo*, that Uyehara could be combined with other references, the cited references Register and Song fail to cure the deficiencies of Uyehara.

In particular, Register fails to teach or suggest that the image is displayed over both a first display area and a second display area on the display screen, wherein the first and second display areas are juxtaposed each other on the display screen, and wherein a substantial portion of both the first display area and the second display area is used for displaying the image, as recited in claim 51.

With respect to claim 71, Register fails to cure the deficiencies of Uyehara as it fails to teach or suggest rotating the image in a first direction, wherein the first directional key flickers to indicate a change in the image's orientation; and resizing the rotated image so that  $C$  is approximately equal to  $A$  and  $D$  is approximately equal to square of  $A$  divided by  $B$ , in response to determining that the rotated image does not fit entirely on the display screen. Applicant has reviewed Register but cannot find any portion of Register that teaches or suggests the same.

For the above reasons, neither of the references either alone or in combination teach or suggest the claimed subject matter. Further, while the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does

not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed. Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,<sup>2</sup> or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.<sup>3</sup>

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn.

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<sup>2</sup> *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

<sup>3</sup> "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in claims 51 and 71. Therefore, it is respectfully submitted that claims 51 and 71 in condition for allowance. Claims 52, 53, and 56 depend on claim 51 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 57 substantially incorporates the elements of claim 51; therefore, claim 57 and claims 58-63 depending from claim 57 should also be in condition for allowance.

The Examiner is also request to carefully examine new claims 72 and 73 and point out portions of the cited references that teach or suggest the recited elements therein. Regardless said claims should be in condition for allowance by the virtue of their dependence on an allowable base claims, namely claim 71.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Waimey

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